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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,340	03/07/2001	Don M. Simpson	STL920000077US1	4769

45112 7590 07/14/2005

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EXAMINER	
NGUYEN, CAM LINH T	

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,340	SIMPSON ET AL.	
	Examiner	Art Unit	
	CamLinh Nguyen	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to the RCE filed on 8/3/2004.

2. Applicant's arguments filed 5/6/2004 have been fully considered but they are not persuasive.

3. Claims 1 – 22 are currently pending for further processing.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 3 – 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform

some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In Bowman (Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although Bowman discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although claims 1, 3 – 11 recite an abstract idea of a method for identifying objects referenced in a stream of text, however, the language of the claims raise a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter. The Examiner suggests Applicant to amend the claims such as "a computer implemented method" instead of "a method" as claimed in claim 1

6. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four statutory categories of invention.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20 of U.S. Patent No. 6,813,616 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim same subject matter. In the U.S. Patent No. 6,813,616 B2, applicant claimed a method for generating a semantic network that capable identifying word patterns in text. In the instant application, applicant also claims a method for identifying object identified by word pattern in the semantic network. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been *prima facie* obvious to one with ordinary skill in the art at the time the invention was made to broaden the claims as in the instant application at no additional cost.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Oyanagi et al (U.S. 4,815,005).

♦ As per claims 1, 13,

Oyanagi et al (U.S. 4,815,005) discloses a method for identifying objects referenced in a stream of text, comprising:

- Receiving an incoming stream of text comprised of words" See col. 5, lines 4 – 41. " An incoming stream of text" corresponds to the question/query (Does CLYDE own NEST 1?) that comprises plurality of words.
- "Consulting a semantic network to automatically identifying one or more word patterns in the incoming stream of text ("CLYDE" and "NEST 1") with a single examination of each word" See col. 5, lines 4 - 41. Oyanagi teaches that the word patterns "CLYDE – object" or "NEST1- value" are identified. The examination is completed in one circle (col. 5, lines 11 – 13.)
- "Referencing a known object identified by word pattern of the semantic network" See col. 5, lines 8 – 11, 14 – 28.

♦ As per claims 2, 14,

- "Loading the semantic network substantially entirely into RAM memory of a processor" See Fig. 1, element 10, col. 3, lines 44 – 46, col. 4, lines 34 – 42.

Oyanagi implements the semantic network in a memory that can be accessed and executed; therefore, the "RAM" is inherent in this memory.

♦ As per claims 3, 6 – 8, 15, 18 – 20,

- "Dividing the stream of text into a plurality of threads and conducting the step of consulting … word patterns". Referring to col. 5, lines 44 – col. 6, lines 23, Oyanagi teaches that a plurality of processing are executed. At least two processes are executed in parallel (memory 14, and 20, col. 4, lines 60 – 61.) While the main memory searches for the object- values, the sub memory searches attributes that are not stored in main memory (col. 4, lines 45 – 48).

♦ As per claims 4, 16,

- "Consulting a semantic network of recognized words and patterns of words in a hierarchical order moving from identified nodes to related nodes linked with the identified nodes" See Fig. 2, col. 4, lines 7 – 15.

♦ As per claims 5, 17,

- "Examining words in the stream of text in a sequential order as the words are received" See col. 2, lines 3 – 8.

♦ As per claims 9 – 11, 21 – 22,

- "Presenting the identified known objects to a user" See col. 6, lines 66 – col.7, lines 3.
- "Providing links between identified word patterns" See Fig. 2.

♦ As per claim 12,

Claim 12 is rejected based on the rejections of claims 1 – 11.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Richardson et al (U.S. 6,098,033).

♦ As per claims 1, 13,

Richardson discloses a method for identifying objects referenced in a stream of text (See col. 1, lines 57 – 59 and col. 4, lines 55 – 61), comprising:

- Receiving an incoming stream of text comprised of words" See col. 1, lines 57 – 59. "
- "Consulting a semantic network to automatically identifying one or more word patterns in the incoming stream of text with a single examination of each word" See col. 3, lines 62 – col. 4, lines 1 and col. 4, lines 15 – 20.
- "Referencing a known object identified by word pattern of the semantic network" See col. 2, lines 40 – 47 and 60 – 65.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 2 – 12, 14 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al (U.S. 6,098,033) in view of Oyanagi et al (U.S. 4,815,005).

♦ As per claims 2, 14,

Richardson does not clearly teach: "Loading the semantic network substantially entirely into RAM memory of a processor"

However, Oyanagi, on the other hand, discloses a computer system that capable identifying word pattern in text comprising a computer that capable of "Loading the semantic network substantially entirely into RAM memory of a processor" See Fig. 1, element 10, col. 3, lines 44 – 46, col. 4, lines 34 – 42. Oyanagi implements the semantic network in a memory that can be accessed and executed; therefore, the "RAM" is inherent in this memory.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Oyanagi into the invention of Richardson because the combination would provide a complete system for the user to search for an object in the database using a computer.

♦ As per claims 3, 6 – 8, 15, 18 – 20, the combination of Richardson and Oyanagi disclose:

- "Dividing the stream of text into a plurality of threads and conducting the step of consulting … word patterns". Referring to col. 5, lines 44 – col. 6, lines 23, Oyanagi teaches that a plurality of processing are executed. At least two processes are executed in parallel (memory 14, and 20, col. 4, lines 60 – 61.)

While the main memory searches for the object- values, the sub memory searches attributes that are not stored in main memory (col. 4, lines 45 – 48).

♦ As per claims 4, 16, the combination of Richardson and Oyanagi disclose:

- "Consulting a semantic network of recognized words and patterns of words in a hierarchical order moving from identified nodes to related nodes linked with the identified nodes" See Fig. 2, col. 4, lines 7 – 15 of Oyanagi.

♦ As per claims 5, 17, the combination of Richardson and Oyanagi disclose:

- "Examining words in the stream of text in a sequential order as the words are received" See col. 2, lines 3 – 8 of Oyanagi.

♦ As per claims 9 – 11, 21 – 22, the combination of Richardson and Oyanagi disclose:

- "Presenting the identified known objects to a user" See col. 6, lines 66 – col.7, lines 3 of Oyanagi.
- "Providing links between identified word patterns" See Fig. 2 of Oyanagi.

♦ As per claim 12, the combination of Richardson and Oyanagi disclose:

Claim 12 is rejected based on the rejections of claims 1 – 11.

Response to Arguments

15. Applicant's arguments with respect to claims 1 - 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272 - 4024. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272 - 4023. The fax phone number for the organization where this application or proceeding is assigned is 571 – 273 - 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen, Cam-Linh

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ALFORD KINDRED
PRIMARY EXAMINER

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